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09/755,787	01/05/2001	Paul Robert Carini	YOR920000056US1	5263
7590	04/07/2004		EXAMINER	
Ryan, Mason & Lewis, LLP 90 Forest Avenue Locust Valley, NY 11560			BELL, PAUL A	
			ART UNIT	PAPER NUMBER
			2675	9
DATE MAILED: 04/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/755,787	CARINI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	PAUL A BELL	2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 January 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

DETAILED ACTION

**Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 7-15, 17-26, 28-36, and 38-42, are rejected under 35 U.S.C. 102(b) as being anticipated by Ruedisueli et al. (5,838,819).

With regard to independent claim 1, Ruedisueli et al. teaches a method of entering formatted electronic ink data provided in association with a user on a handwriting system (abstract and figure 1), the method comprising the steps of: positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system (figure 2, items 30 "paper" and 32 "clip"), physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figures 2 and 3, item 34 shows a hand physically putting ink on the paper on top of the digitizer), **wherein the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format** such that the on electronic ink data entered at the digitizing surface is computer parse able based on the one or more fields (column 2, lines 10-31), and further **wherein a field comprises a delimited area of the writing medium** (figure 2 shows an identifier item 36 being put

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in a region (or delimited area) for recording the page number and figure 3 shows another region (or delimited area) for recording a graph with a label. In addition examiner sites Ruedisueli et al. figures 5a-c, 6a-c and 7a-c which illustrate alternative modes of operation using page identifiers), and **providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields** (figures 2 and 3 whereby the user can see the ink as he writes it on the paper associated with the page number reads on **this broad language** for example; I write the number 1, a indication of page number when put in the upper right corner simply reads on this broad language ), so as to permit **a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields** (column 4, lines 5-16 also see column 2, lines 10-31 whereby the user has the capability to determine which data to be entered is associated or not associated with a specific "page" or "session" reads on this broad language also even in the context of using only two page reads on this broad language for example figures 2 and 3 illustrate the concept of associating a certain graph with page 1 and now if I put in another sheet and put a number 2 in the upper right corner and then put a pie chart on page 2 that pie chart will not be associated with page 1).

With regard to independent claim 18, Ruedisueli et al. teaches a method of entering formatted electronic ink data provided in association with a user on a handwriting system (abstract and figure 1), the method comprising the steps of:

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positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system (figure 2, items 30 "paper" and 32 "clip"), physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figures 2 and 3, item 34 shows a hand physically putting ink on the paper on top of the digitizer), and providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields of a predefined format (figures 2 and 3 whereby the user can see the ink as he writes it on the paper associated with the page number reads on this broad language), wherein a field comprises a delimited area of the writing medium (figure 2 shows an identifier item 36 being put in a region (or delimited area) for recording the page number and figure 3 shows another region (or delimited area) for recording a graph with a label), such that the electronic ink data entered in association therewith at the digitizing surface is computer parse able based on the one or more fields (column 2, lines 10-31), and such as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16 also see column 2, lines 10-31 whereby the user has the capability to determine which data to be entered is associated or not associated with a specific "page" or "session" reads on this broad language).

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With regard to independent claim 22, Ruedisueli et al. teaches a handwriting system for entering formatted electronic ink data provided in association with a user, the system (abstract and figure 1), comprising: a digitizing surface (figure 2, item 26); a stylus (figure 2, item 34 "pen"); and one or more pieces of writing medium (figure 2, items 30 "paper" and 32 "clip"), wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figures 2 and 3, item 34 shows a hand physically putting ink on the paper on top of the digitizer). further wherein the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer parse able based on the one or more fields (column 2, lines 10-31), wherein a field comprises a delimited area of the writing medium (figure 2 shows an identifier item 36 being put in a region (or delimited area) for recording the page number and figure 3 shows another region (or delimited area) for recording a graph with a label), such that one or more user-specified indications can be provided to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields (figures 2 and 3 whereby the user can see the ink as he writes it on the paper associated with the page number reads on this broad language), so as to permit a transition between the entry of electronic ink data in

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accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16 also see column 2, lines 10-31 whereby the user has the capability to determine which data to be entered is associated or not associated with a specific "page" or "session" reads on this broad language).

With regard to independent claim 39, Ruedisueli et al. teaches a handwriting system for entering formatted electronic ink data provided in association with a user (abstract and figure 1), the system comprising: a digitizing surface (figure 2, item 26); a stylus (figure 2, item 34 "pen"); and one or more pieces of writing medium (figure 2, items 30 "paper" and 32 "clip") wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figures 2 and 3, item 34 shows a hand physically putting ink on the paper on top of the digitizer). further wherein one or more user-specified indications can be provided in accordance with the one or more pieces of writing medium to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields of a predefined format (figures 2 and 3 whereby the user can see the ink as he writes it on the paper associated with the page number reads on this broad language), wherein a field comprises a delimited area of the writing medium (figure 2 shows an identifier item 36 being put in a region (or delimited area) for

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recording the page number and figure 3 shows another region (or delimited area) for recording a graph with a label), such that the electronic ink data entered in association therewith at the digitizing surface is computer parse able based on the one or more fields (column 2, lines 10-31), and such as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16 also see column 2, lines 10-31 whereby the user has the capability to determine which data to be entered is associated or not associated with a specific "page" or "session" reads on this broad language).

With regard to claim 2 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has the predefined format for entry of electronic ink data in accordance with the one or more fields and at least one of the pieces of writing medium does not have the predefined format, such that the user may transition between the two pieces of writing medium when performing formatted electronic ink data entry and unformatted electronic ink data entry, respectively (figure 5b item 36 and item 50 and figure 5c item 54).

With regard to claim 3 Ruedisueli et al. teaches wherein the one or more fields of the one or more pieces of writing medium are preprinted in watermark form thereon, such that the user may transition between performing formatted electronic ink data entry and unformatted electronic ink data entry on the same piece of writing medium (figure 12).

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With regard to claim 4 Ruedisueli et al. teaches wherein the one or more fields of the predefined format are associated with a label (page number is a label also figure 2 shows the user putting a label on the graph).

With regard to claim 5 Ruedisueli et al. teaches wherein the label is associated with an information management function (the page number helps you keep track of your notes).

With regard to claim 7 Ruedisueli et al. teaches wherein the user-specified indication providing step further comprises the step of the user signaling the beginning of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 40).

With regard to claim 8 Ruedisueli et al. teaches wherein the user-specified indication providing step further comprising the step of the user signaling completion of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 42).

With regard to claim 9 Ruedisueli et al. teaches further comprising the step of providing the user with feedback relating to the user's entry of formatted electronic ink data in accordance with the one or more fields (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 10 Ruedisueli et al. teaches wherein the feedback is at least one of auditory and visible (figures 2 and 3 the user can see the ink on the paper).

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With regard to claim 11 Ruedisueli et al. teaches wherein the feedback relates to whether or not the user is writing within one of the fields (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 12 Ruedisueli et al. Teaches wherein the feedback relate to whether or not the user has completed one or more required fields (the page number entered by user reads on “required field” because it is needed to store the data with the correct page).

With regard to claim 13 Ruedisueli et al. teaches wherein the handwriting system is a personal digital notepad (figure 2 and 12).

With regard to claim 14 Ruedisueli et al. teaches wherein the one or more pieces of writing medium are bound together to form a grouping (column 11, lines 18-29).

With regard to claim 15 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has a carbon paper backing (column 9, line 19).

With regard to claim 17 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has the predefined format on only a portion of the writing medium (figure 7c, item 68).

With regard to claim 19 Ruedisueli et al. teaches, wherein at least one of the user-specified indications comprises at: least one of a letter, a symbol and a word (figures 2 and 3 show letters, numbers and a graph).

With regard to claim 20 Ruedisueli et al. teaches wherein at least one of the user-specified indications comprises at least one handwritten stroke (figure 3).

With regard to claim 21 Ruedisueli et al. Teaches further comprising the step of permitting at least one of user addition, deletion and modification of one or more fields (column 2, lines 25-29).

With regard to claim 23 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has the predefined format for entry of electronic ink data in accordance with the one or more fields and at least one of the pieces of writing medium does not have the predefined format, such that the user may transition between the two pieces of writing medium when performing formatted electronic ink data entry and unformatted electronic ink data entry, respectively (figure 5b item 36 and item 50 and figure 5c item 54).

With regard to claim 24 Ruedisueli et al. teaches wherein the one or more fields of the one or more pieces of writing medium are preprinted in watermark form thereon, such that the user may transition between performing formatted electronic ink data entry and unformatted electronic ink data entry on the same piece of writing medium (figure 12).

With regard to claim 25 Ruedisueli et al. teaches wherein the one or more fields of the predefined format are associated with a label (page number is a label).

With regard to claim 26 Ruedisueli et al. teaches wherein the label is associated with an information management function (the page number helps you keep track of your notes).

With regard to claim 28 Ruedisueli et al. teaches, wherein, in accordance with the one or more user specified indications, the system is further operative to permit the

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user to signal the beginning of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 40).

With regard to claim 29 Ruedisueli et al. teaches wherein in accordance with the one or more user specified indications, the system is further operative to permit the user to signal completion of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 42).

With regard to claim 30 Ruedisueli et al. teaches wherein the system is further operative to provide the user with feedback relating to the user's entry of formatted electronic ink data in

accordance with the one or more fields (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 31 Ruedisueli et al. teaches wherein the feedback is at least one of auditory and visible (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 32 Ruedisueli et al. teaches wherein the feedback relates to whether or not the user is writing within one of the fields (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 33 Ruedisueli et al. Teaches wherein the feedback relate to whether or not the user has completed one or more required fields (the page number entered by user reads on "required field" because it is needed to store the data with the correct page).

With regard to claim 34 Ruedisueli et al. teaches wherein the handwriting system is a personal digital notepad (figure 2 and 12).

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With regard to claim 35 Ruedisueli et al. teaches wherein the one or more pieces of writing medium are bound together to form a grouping (column 9, line 19).

With regard to claim 36 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has a carbon paper backing (column 9, line 19).

With regard to claim 38 Ruedisueli et al. teaches, wherein at least one of the pieces of writing medium has the predefined format on only a portion of the writing medium (figure 7c, item 68).

With regard to claim 40 Ruedisueli et al. teaches, wherein at least one of the user-specified indications comprises at least one of a letter, a symbol and a word (figures 2 and 3 show letters, numbers and a graph).

With regard to claim 41 Ruedisueli et al. teaches wherein at least one of the user-specified indications comprises at least one handwritten stroke (figure 3).

With regard to claim 42 Ruedisueli et al. Teaches further comprising the step of permitting at least one of user addition, deletion and modification of one or more fields (column 2, lines 25-29)

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 27are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruedisueli et al. as applied to claims 1, 4, 5, 22, 25, 26, above, and further in view of Gusack (5,921,582).

With regard to claims 6 and 27 Ruedisueli et al. does not illustrate wherein the information management function comprises at least one of an appointment recording function, a phone message recording function and a listing function of task to be accomplished. However this recited use of the digitizer is viewed as merely directed toward an "OBVIOUS INTENDED USE" of the Ruedisueli et al. digitizer.

Gusack teaches, wherein the information management function comprises a listing of task to be accomplished (See Gusack figure 19 listing of task 1-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ruedisueli et al. digitizer to perform tasking as taught by Gusack because the Ruedisueli et al. apparatus is capable of being used that way and Gusack which is analyst art shows a similar digitizer being used that way which lends support to the concept of a recitation merely directed towards an obvious intended use.

5. Claims 16, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruedisueli et al. as applied to claims 1 and 22 above, and further in view of Gannage et al. (6,504,956).

With regard to claims 16 and 37 Ruedisueli et al. does not illustrate wherein at least one of the pieces of writing medium has an at least partially adhesive backing. However he does in column 11, lines 20-22 state, "the means for attaching a paper, such as clip 32" this language "such as" extends the expression to suggest other means which are obvious alternatives such as adhesive.

Gannage et al. teaches using paper for his digitizer in the form of "Post-it" notes (See Gannage et al. abstract, figure 5) which have an adhesive backing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ruedisueli et al. to use adhesive backed paper as taught by Gannage et al. because the Ruedisueli et al. base reference directly uses suggestive language directed towards all obvious equivalent alternatives for "means for attaching" and further since Gannage et al. is analysis art, the alternatives offered by Gannage et al. would of have been considered at time of invention by one of ordinary skill.

***Response to Arguments***

6. Applicant's arguments filed 1/26/2004 have been fully considered but they are not persuasive.

The applicant argues with regard to claim 1, "Thus, Ruedisueli does not teach or suggest that **"one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format.....wherein a field comprises a delimited area of the writing medium,"**

The examiner disagrees because the cited sections which teach; "The electronic identifiers of the plurality of sessions facilitate the management of the electronic copies, such as the collecting together and **merging of sessions having similar identifiers.**"

"The disclosed electronic notepad using identifiers of sessions allows a user to return to a **previous sheet of handwritten notes** to modify previously stored electronic notes".

And in regards to the limitation “**a field comprises a delimited area of the writing medium,**” The Ruedisueli et al. figure 2 shows an identifier item 36 being put in a region (or delimited area) for recording the page number and figure 3 shows another region (or delimited area) for recording a graph with a label. In addition examiner sites Ruedisueli et al. figures 5a-c, 6a-c and 7a-c which illustrate alternative modes of operation using page identifiers.

The applicant further argues with regard to claim 1, Ruedisueli does not teach or suggest, “**providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields**”.

The examiner disagrees because the Ruedisueli et al. shows figures 2 and 3 whereby the user can see the ink as he writes it on the paper associated with the page number reads on this broad language for example; I write the number 1, a indication of page number when put in the upper right corner simply reads on this broad language.

The applicant further argues with regard to claim 1, Ruedisueli does not teach or suggest, “**a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields**”.

The examiner disagrees because Ruedisueli et al. column 4, lines 5-16 also see column 2, lines 10-31 whereby the user has the capability to determine which data to be

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entered is associated or not associated with a specific "page" or "session" reads on this broad language also even in the context of using only two page reads on this broad language for example figures 2 and 3 illustrate the concept of associating a certain graph with page 1 and now if I put in another sheet and put a number 2 in the upper right corner and then put a pie chart on page 2 that pie chart will not be associated with page 1).

### Comments

7. Ruedisueli et al. clearly demonstrates at least the simple concept of having ONE formatted delimited area (upper right corner) where the user puts a indication of his page number and the remaining page seems to be ONE big free-form unformatted delimited area as shown by Ruedisueli figures 2 and 3.

Applicant clearly demonstrates a more complex concept of having a PLURALITY of formatted delimited areas where the user puts specific information such as Date or Start time and a PLURALITY of free-form unformatted delimited areas such as Location or Other as shown by applicant in figure 4.

The examiner maintains that due to the broad language presently used in the claims that it simply reads on the simple concept presented by Ruedisueli . The examiner believes it may be possible to present "new issues" that could possibly overcome this 102 rejection since you do seem to possibly illustrate a more complex concept but such changes when entered would require further consideration and/or search as to anticipation or obviousness in view of the prior art.

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Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Bell whose telephone number is (703) 306-3019.

If attempts to reach the examiner by telephone are unsuccessful the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377 can help with any inquiry of a general nature or relating to the status of this application.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or Faxed to: (703) 872-9306

Or Hand-delivered to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor  
(Receptionist)

*Paul Bell*

Paul Bell  
Art unit 2675  
April 2, 2004

*Chanh Nguyen*  
CHANH NGUYEN  
PRIMARY EXAMINER